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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,454	05/24/2001	Satoru Kosuge	DP-767 US	9838

466 7590 12/21/2005

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

EXAMINER

PHILLIPS, HASSAN A

ART UNIT PAPER NUMBER

2151

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,454

Applicant(s)

KOSUGE, SATORU

Examiner

Hassan Phillips

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14 and 16-29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to communications filed on September 29, 2005.

Response to Arguments

2. Applicant's arguments filed September 29, 2005 have been fully considered but they are not persuasive. Applicant argued that:

- a) Shuman does not teach shortening text of an email by including registered keywords from within the email, and excluding words intermediate the registered keywords.
- b) Fernandez fails to teach registered keywords including dates, place names, proper names and individually set particular terms, and group keywords including an occupation, an occupational type and an age group of an electronic mail sender and receiver.

Examiner respectfully disagrees with Applicant's assertions.

3. Regarding item a), Examiner agrees with Applicant that the cited passage of Shuman teaches creating a new data element, (i.e. the infobar), which is populated with important information **extracted** or derived from the contents of the electronic information, (col. 11, line 65, through col. 12, line 8). Examples are given in the teachings of Shuman of how an infobar can be used to display derived information used with email and meeting request messages (Fig.'s 6-8). It is also clear throughout the teachings of Shuman that important information can be **extracted** from the email

message itself and presented in the infobar, (col. 2, lines 19-42, col. 11, line 65, through col. 12, line 8). Such a method taught by Shuman implies keywords are registered within the email. Thus, Examiner maintains Shuman teaches shortening text of an email by including registered keywords from within the email, and excluding words intermediate the registered keywords.

4. Regarding item b), Examiner maintains Fernandez teaches an analysis means for selectively shortening the message portion of an email to retain text corresponding to registered keywords and to leave out words not corresponding to the registered keywords (page 10, lines 24-28), wherein the keywords are numeric values representing a maximum message length limit, (page 5, lines 5-15). Examiner also maintains that the combined teachings of Fernandez and Shuman provide a means for teaching the registered keywords to include dates, place names, proper names and individually set particular terms, and group keywords including an occupation, an occupational type and an age group of an electronic mail sender and receiver since Shuman teaches the registered keywords can be extracted from an email message, (Shuman, col. 2, lines 19-42, col. 11, line 65, through col. 12, line 8). Dates, place names, proper names and individually set particular terms, and group keywords including an occupation, an occupational type and an age group of an electronic mail sender and receiver are all words that can be extracted from an email. As indicated in the previous action, one of ordinary skill in the art would combine the teachings of

Fernandez with Shuman to make a user aware of important information contained in the text of the received email, (Shuman, col. 12, lines 5-8).

5. Accordingly the references supplied by the examiner in the previous office action covers the claimed limitations. The rejections are thus sustained. Applicant is requested to review the prior art of record for further consideration.

6. Examiner appreciates Applicant pointing out minor format errors made by the Examiner in rejecting claims 24 and 29. Examiner has corrected these minor errors in the following rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 6, 7, 11, 14, 17, 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez, WO 99/65256 (supplied by Applicant), in view of Shuman et al. (hereinafter Shuman), U.S. Patent 6,708,202.

9. In considering claims 1, 3, 11, and 17, Fernandez teaches an electronic mail processing system, method, and device comprising: receiving means for receiving electronic mail sent to a receiver via Internet, (page 5, lines 1-15); analysis means for receiving the electronic mail sent from a sending means via the internet and for carrying out a keyword analysis of a message portion of the received electronic mail on the basis of keywords previously registered by the receiver to obtain a short text of the message portion, the analysis means selectively shortening the message portion to retain text corresponding to the registered keywords and to leave out words not corresponding to the registered keywords, (page 10, lines 24-28); storing means for storing the short text of the electronic mail obtained after the keyword analysis, (page 5, lines 1-15); and sending means for sending the short text of the electronic mail stored in the storing means to the receiver via the Internet in response to access of the receiver, (page 5, lines 1-15).

Although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose: the text of the email being shortened into a short text, by including registered keywords and excluding words intermediate the registered keywords.

Nevertheless, in a similar field of endeavor, Shuman teaches a method for highlighting information contained in an email comprising: shortening the text of the email by including registered keywords from within the email, and excluding words intermediate the registered keywords, (col. 11, line 65 through col. 12, line 8).

Thus, given the teachings of Shuman it would have been obvious to a person of ordinary skill in the art to modify the teaching of Fernandez to show the registered keywords as text in the received email, and shortening the text of the email by including the registered keywords and excluding words intermediate the registered keywords. This would have advantageously made the user aware of important information contained in the text of the received email, Shuman, col. 12, lines 5-8.

10. In considering claims 6, 14, and 19, Fernandez teaches an electronic mail processing system, method, and device comprising: receiving means for receiving electronic mail sent to a receiver via internet; voice conversion means for receiving the electronic mail sent from a sending means via the internet and for converting content of the received electronic mail into voice signals, (page 5, lines 1-15); an analysis means for carrying out a keyword analysis of the received electronic mail on the basis of keywords previously registered by the receiver to obtain a short text of a message portion of the electronic mail, the analysis means selectively shortening the message portion to retain text corresponding to the registered keywords and to leave out words not corresponding to the registered keywords, (page 10, lines 24-28); reading out means for reading out the voice signals output from the voice conversion means to produce voiced electronic mail, (page 5, lines 1-15); and sending means for sending the voiced electronic mail produced by the reading out means to the receiver via a public telephone network in response to access of the receiver, (page 5, lines 1-15).

Although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose: the text of the email being shortened into a short text, by including registered keywords and excluding words intermediate the registered keywords.

Nevertheless, in a similar field of endeavor, Shuman teaches a method for highlighting information contained in an email comprising: shortening the text of the email by including registered keywords from within the email, and excluding words intermediate the registered keywords, (col. 11, line 65 through col. 12, line 8).

Thus, given the teachings of Shuman it would have been obvious to a person of ordinary skill in the art to modify the teaching of Fernandez to show the registered keywords as text in the received email, and shortening the text of the email by including the registered keywords and excluding words intermediate the registered keywords. This would have advantageously made the user aware of important information contained in the text of the received email, Shuman, col. 12, lines 5-8.

11. In considering claim 7, the teachings of Fernandez further show a document output means for outputting a selected reply document in response to a signal sent from the public telephone network, and a reply sending means for preparing electronic mail from the reply document output from the document output means and for sending the prepared electronic mail to the electronic mail sender via the Internet. See page 6, lines 10-16.

12. Claims 2, 4, 5, 8, 9, 12, 13, 16, 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez and Shuman in view of Scannell et al. (hereinafter Scannell), U.S. Patent 5,377,354 (supplied by Applicant).

13. In considering claims 2, 4, 8, 9, and 16, although the modified system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose: rearranging the received email.

Nevertheless, in a similar field of endeavor, Scannell teaches a method and system comprising: a rearrange means for receiving electronic mail sent from a sending means via the Internet and for rearranging the received electronic mail in a priority order previously registered by a receiver of the electronic mail, (col. 2, lines 34-48).

Thus given the teachings of Scannell, it would have been obvious to a person of ordinary skill in the art to further modify the teaching of Fernandez to show the receiver registering electronic mail in a priority order so that the received electronic mail can be rearranged for the receiver. Doing so would have provided the receiver with an improved automatic message sorting system driven by the rules created and modified by the receiver, (col. 2, lines 28-31).

14. In considering claims 5, 12, and 18, Fernandez teaches an electronic mail processing system, method, and device comprising: receiving means for receiving electronic mail sent to a receiver via Internet, (page, 5, lines 1-15); storing means for storing the received electronic mail, (page, 5, lines 1-15); an analysis means for carrying

out a keyword analysis of the received electronic mail on the basis of keywords previously registered by the receiver to obtain a short text of a message portion of the electronic mail, the analysis means selectively shortening the message portion to retain text corresponding to the registered keywords and to leave out words not corresponding to the registered keywords, (page 10, lines 24-28); and, a second sending means for sending the received electronic mail stored in the storing means to the receiver via the internet in response to access of the receiver, (page, 5, lines 1-15).

Although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose: the text of the email being shortened into a short text, by including registered keywords and excluding words intermediate the registered keywords.

Nevertheless, in a similar field of endeavor, Shuman teaches a method for highlighting information contained in an email comprising: shortening the text of the email by including registered keywords from within the email, and excluding words intermediate the registered keywords, (col. 11, line 65 through col. 12, line 8).

Thus, given the teachings of Shuman it would have been obvious to a person of ordinary skill in the art to modify the teaching of Fernandez to show the registered keywords as text in the received email, and shortening the text of the email by including the registered keywords and excluding words intermediate the registered keywords. This would have advantageously made the user aware of important information contained in the text of the received email, Shuman, col. 12, lines 5-8.

Although the modified system of Fernandez shows substantial features of the claimed invention, it fails to further expressly disclose: rearranging the received email.

Nevertheless, in a similar field of endeavor, Scannell teaches a method and system comprising: a rearrange means for receiving electronic mail sent from a sending means via the Internet and for rearranging the received electronic mail in a priority order previously registered by a receiver of the electronic mail, (col. 2, lines 34-48).

Thus given the teachings of Scannell, it would have been obvious to a person of ordinary skill in the art to further modify the teaching of Fernandez to show the receiver registering electronic mail in a priority order so that the received electronic mail can be rearranged for the receiver. Doing so would have provided the receiver with an improved automatic message sorting system driven by the rules created and modified by the receiver, (col. 2, lines 28-31).

15. In considering claim 13, the method taught by Fernandez discloses storing the short text of the electronic mail after the keyword analysis in the receive mailbox, (page 5, lines 1-15).

16. Claim 10, is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez in view of Shuman, and further in view of Nelson, U.S. Patent 6,061,718 (supplied by Applicant).

17. In considering claim 10, Fernandez teaches an electronic mail processing system comprising: first sending means for sending voiced electronic mail to a receiver via a public telephone network, (page 5, lines 1-15); storing means for storing the voiced electronic mail, (page 5, lines 1-15); an analysis means for carrying out a keyword analysis of the received electronic mail on the basis of keywords previously registered by the receiver to obtain a short text of a message portion of the electronic mail, the analysis means selectively shortening the message portion to retain text corresponding to the registered keywords and to leave out words not corresponding to the registered keywords, (page 10, lines 24-28); and second sending means for sending the received electronic mail stored in the storing means to the receiver via the Internet in response to access of the receiver of the voiced electronic mail, (page 5, lines 1-15).

Although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose: the text of the email being shortened into a short text, by including registered keywords and excluding words intermediate the registered keywords.

Nevertheless, in a similar field of endeavor, Shuman teaches a method for highlighting information contained in an email comprising: shortening the text of the email by including registered keywords from within the email, and excluding words intermediate the registered keywords, (col. 11, line 65 through col. 12, line 8).

Thus, given the teachings of Shuman it would have been obvious to a person of ordinary skill in the art to modify the teaching of Fernandez to show the registered keywords as text in the received email, and shortening the text of the email by including

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the registered keywords and excluding words intermediate the registered keywords.

This would have advantageously made the user aware of important information contained in the text of the received email, Shuman, col. 12, lines 5-8.

Although the modified system of Fernandez shows substantial features of the claimed invention, it fails to further expressly disclose: converting the voiced electronic mail to text.

Nevertheless, Nelson teaches a method comprising: a conversion means for receiving voiced electronic mail sent from a first sending means via the public telephone network and for converting content of the voiced electronic mail into a text as content of a communication matter, (col. 4, lines 59-67, col. 5, lines 1-3).

Thus given the teachings of Nelson, it would have been obvious to a person of ordinary skill in the art to further modify the teaching of Fernandez to show a conversion means for converting the voiced electronic mail to text. This would have provided an efficient means for allowing the receiver to optionally receive messages in voice or text format, Nelson, col. 4, lines 59-67, col. 5, lines 1-3.

18. Claims 20, 22, 25, 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez and Shuman in view of Chong et al. (hereinafter Chong), U.S. Patent 5,497,319 (supplied by Applicant).

19. In considering claims 20, 22, 25, and 26, although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly

disclose: sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising: a conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link, (col. 3, lines 33-54).

Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Fernandez to have a have a conversion processor between a personal computer and a mobile device. This would have allowed to owner of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

20. Claims 21, 23, 24, 27, 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez, Shuman, and Scannell, in view of Chong.

21. In considering claims 21, 23, 27, and 28, although the disclosed system of Fernandez and Scannell shows substantial features of the claimed invention, it fails to expressly disclose: sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising: a conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link, (col. 3, lines 33-54).

Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Fernandez and Scannell to have a have a conversion processor between a personal computer and a mobile device. This would have allowed to owner of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

22. In considering claim 24, although the disclosed system of Scannell shows substantial features of the claimed invention, it fails to expressly disclose: sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising: a conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link, (col. 3, lines 33-54).

Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Scannell to have a have a conversion processor between a personal computer and a mobile device. This would have allowed to owner of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

23. Claim 29, is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez, Shuman, and Nelson in view of Chong.

24. In considering claim 29, although the disclosed system of Nelson shows substantial features of the claimed invention, it fails to expressly disclose: sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising: a conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link, (col. 3, lines 33-54).

Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Nelson to have a have a conversion processor between a personal computer and a mobile device. This would have allowed

to owner of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

Conclusion

25. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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12/12/05


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER